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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86230383
Applicant	Unistrut International Corporation
Applied for Mark	U
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*In re Unistrut International Corporation*

Mark: 

Attorney Reference: 1532TUN04168

## I. Issue on Appeal

Applicant seeks to register the mark  for the goods shown below. The Examining Attorney has issued a final requirement that Applicant amend the goods **bolded** below:

## Class 6

Building and framing accessory and installation components all made of metal, namely, nuts, bolts, screws, washers for use as hardware, studs, hinges, springs for use as hardware, spring clips for use as hardware, pipe couplings, pipe clamps, pipe rollers for use as hardware, pipe hangers, fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers; **structural building and framing products, namely, rolled and extruded metal sections; sectional metallic building units and couplings, fittings, and connections therefor, adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures; metal electrical and electronic installation products and accessory components, namely, cable trays and supports, conduits, bus duct and bus bar supports, cable saddles and supports, bus bar clamps, bus duct connectors, and wiring stud nuts**

## Class 9

**Electrical and electronic installation products and accessory components, namely, raceways, switch plates, outlets and outlet plates, conduit connection**



**fittings and connectors, outlet box connection fittings, fibre wire retainers in the nature of reels for electrical wire, relay racks for mounting electrical equipment; printed circuit card guide assemblies including framing members, brackets, rubber-phenolic guide elements, or resin or plastic guide elements and insert elements; electricity distribution console assemblies primarily comprised of adjustable framing members adapted to installation of electronic equipment facing members; electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators**

Class 11

**Electrical and electronic installation products and accessory components, namely, fittings for fluorescent lighting fixtures**

Class 17

**Building and framing accessory and installation components, namely, rubber washers and plastic conduits**

Class 19

**Non-metal structural building and framing products, and accessory components therefor, namely, trolley and conveyor assemblies and parts, end caps and closure strips for channel and tubing members, shelf brackets, beam clamps, concrete inserts, partition and display fittings and moldings, ducts, and door jambs; non-metal building and framing accessory and installation components, namely, nuts, bolts, screws, studs, hinges, springs for use as hardware, spring clips for use as hardware, pipe couplings, pipe clamps, pipe rollers for use as hardware, pipe hangers, fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers**

This is the only issue on appeal.

## **II. Relevant Prosecution History**

On January 10, 2015, the Examining Attorney issued a final Office Action that required amendments to Applicant's identification of goods, on the ground that portions of the identification were indefinite and/or overly broad in that they could identify goods in more than one international class.



On July 10, 2015, Applicant submitted a request for reconsideration that amended the Class 11 goods and, with respect to the Examining Attorney's remaining objections to the wording in Classes 6, 9, 17, and 19, submitted arguments with citations to the Office's ID Manual as to why the wording should be considered acceptable.

On August 7, 2015, the Examining Attorney denied Applicant's request for reconsideration without addressing any of Applicant's arguments.

### **III. Applicant's Identification of Goods Is Acceptable**

Because the Examining Attorney's denial of Applicant's request for reconsideration did not address Applicant's arguments, Applicant essentially reprints those arguments below on a class-by-class basis.

#### **Class 6**

First, the Examining Attorney objected to "structural building and framing products, namely, rolled and extruded metal sections" in Class 6. Specifically, the Examining Attorney stated that "the type of 'metal section' product must be identified."<sup>1</sup> Applicant notes the following entries are acceptable in Class 6 according to the ID Manual:

- "frames of metal for building"
- "frameworks of metal"
- "building wall framing made primarily of metal"

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<sup>1</sup> All quotations attributed to the Examining Attorney are taken from her final Office Action dated January 10, 2015.



If these three entries are acceptable, then Applicant respectfully submits its “metal sections,” which are stated to be “*structural building and framing products*,” should likewise be acceptable.

Second, the Examining Attorney objected to “sectional metallic building units and couplings, fittings, and connections therefor, adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures” in Class 6. Specifically, the Examining Attorney stated that “the particular types of units, couplings, fittings and connections must be specified.” With respect to the wording “sectional metallic building units . . . adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures,” Applicant respectfully submits this wording is acceptable for the reasons stated above; in other words, this wording is at least as specific as the acceptable wording “frames of metal for building.” Turning then to the “couplings, fittings, and connections therefor” – i.e., for the sectional metallic building units for framing – Applicant does not understand why such couplings, fittings, and connections would not be acceptable. For example, the following wording is acceptable according to the ID Manual:

- “metal *couplings* for fire hoses” in Class 6
- “metal *couplings* for use with hydraulic pneumatic systems” in Class 6
- “pipe *coupling* of metal” in Class 6
- “metal pipes and metal *fittings therefor*” in Class 6
- “tool and tool accessory boxes made of metal sold empty and parts and *fittings therefor*” in Class 6
- “scientific apparatus and instruments, namely, chromatography columns for



use in purification in the laboratory and parts and *fittings therefor*” in Class 9

- “catheters and parts and *fittings therefor*” in Class 10
- “commercial refrigerators and freezers and parts and *fittings therefor*” in Class 11
- “marine equipment, namely, anti-surfing/broaching drogues and parts and *fittings therefor*” in Class 12
- “metal *connectors* for decking and decking joints” in Class 6
- “metal pipe *connectors*” in Class 6
- “structure joint *connectors* of metal” in Class 6
- “cable *connectors*” in Class 9
- “electric *connectors*” in Class 9

In short, if, as Applicant believes, its “sectional metallic building units . . . adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures” are properly classified, then Applicant respectfully submits that “couplings, fittings, and connections” for such products are sufficiently definite and properly classified.

The last clause in Class 6 to which the Examining Attorney objected is “metal electrical and electronic installation products and accessory components, namely, cable trays and supports, conduits, bus duct and bus bar supports, cable saddles and supports, bus bar clamps, bus duct connectors, and wiring stud nuts.” The Examining Attorney stated this wording could include goods in other classes, i.e., “[g]oods that are conductors of electricity are in International Class 9 and metal items that are not conductors are in International Class 6.” The Examining Attorney appears to have misunderstood what



these goods are; they are not conductors of electricity. They are *used with* electrical items, but they are not themselves electrical conductors or the like. For example, metal cable trays, metal conduits, metal clamps, and metal nuts are all classified in Class 6 according to the ID Manual.

### **Class 9**

In Class 9, the first clause to which the Examining Attorney objected is “electrical and electronic installation products and accessory components, namely, raceways, switch plates, outlets and outlet plates, conduit connection fittings and connectors, outlet box connection fittings, fibre wire retainers in the nature of reels for electrical wire, relay racks for mounting electrical equipment.” The Examining Attorney wrote:

Goods that are conductors of electricity are in International Class 9 and metal hardware items that are not conductors are in International Class 6, and non-metal hardware items that are not electricity conductors are in International Class 20. As currently worded the identification states that the goods are products and accessories for installation of electrical and electronic items, but does not specify whether the goods themselves are electrical in nature.

Below Applicant compares its wording with acceptable wording in Class 9 according to the ID Manual:

Applicant’s wording	ID Manual
“electrical...raceways”	“electrical raceways”
“electrical...switch plates”	“electric switch plates”
“electrical...outlets”	“electrical outlets”
“electrical...outlet plates”	“electrical outlet plates”
“electrical...conduit connection fittings and connectors”	“electrical connections” “electrical connectors” ( <i>see remarks above regarding “fittings”</i> )
“electrical...outlet box connection fittings”	“electrical outlets” “electrical outlet box plaster rings”



“electronic installation products and accessory components, namely,...fibre wire retainers in the nature of reels for electrical wire”	“reels for electric wire”
“electronic installation products and accessory components, namely,...relay racks for mounting electrical equipment”	“mounting devices for photographic equipment” ( <i>by analogy</i> )

Applicant respectfully submits that it is readily apparent its wording is acceptable.

The second clause in Class 9 to which the Examining Attorney objected is “printed circuit card guide assemblies including framing members, brackets, rubber-phinolic guide elements, or resin or plastic guide elements and insert elements.” The Examining Attorney objected for two reasons. The first is that “it contains the open-ended wording ‘including.’ See TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with ‘namely.’” However, with all due respect to the Examining Attorney, there is no *per se* rule that the word “including” is unacceptable. As the Board has stated, “[t]he determination of whether the term ‘including’ renders the identification of goods indefinite must be decided on a case-by-case basis in the context of the goods so identified.” *In re Gina Marie Slattery and Kris Johnson*, Serial Nos. 78887793 and 78887799 (T.T.A.B. September 23, 2008) (non-precedential).<sup>2</sup> For example, since “furniture” is acceptable according to the ID Manual, would the Examining Attorney object to “furniture, including chairs” in Class 20?

The second reason the Examining Attorney objected to this wording is on the basis that Applicant must state “whether the items are for assembling circuit cards or

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<sup>2</sup> Although the cited decision is not precedential, Applicant respectfully submits that it nonetheless represents the considered position of three Administrative Trademark Judges.



component parts of circuit cards.” Applicant respectfully disagrees with the Examining Attorney’s objection because “printed circuit card guide assemblies including framing members, brackets, rubber-phenolic guide elements, or resin or plastic guide elements and insert elements” are simply printed circuit card guide assemblies that include the items mentioned. The wording “printed circuits” by itself is acceptable according to the ID Manual, and there is no logical reason why adding the word “assemblies” should render it indefinite. For example, “electronic locks” and “electronic lock assemblies” are both acceptable in Class 9 according to the ID Manual.

The third and fourth clauses in Class 9 to which the Examining Attorney objected are “electricity distribution console assemblies primarily comprised of adjustable framing members adapted to installation of electronic equipment facing members” and “electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators.” The Examining Attorney wrote:

Metal hardware frames, brackets and fittings that are not electric in nature are in International Class 6, electrical items that are parts of assemblies are in International Class 9, non-metal framing such poles for electric power lines and building are in International Class 19.

The wording “electricity distribution consoles” is in Class 9 according to the ID Manual, and as noted above, the addition of the word “assemblies” should not render it indefinite or overly broad. With all due respect to the Examining Attorney, her apparent position that metal items “not electric in nature are in International Class 6” appears too sweeping, for there are numerous goods fitting that description that are properly classified in Class 9. For example, and as noted above, “electrical raceways” and “reels for electric wire”



are in Class 9. Likewise, Applicant’s “electricity distribution console assemblies...” is properly classified in Class 9. The same analysis applies to the fourth clause, namely Applicant’s “electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators.”

### **Class 11**

Applicant respectfully submits that “electrical and electronic installation products and accessory components, namely, fittings for fluorescent lighting fixtures” is acceptable because, by analogy, “ceiling light fittings” and “incandescent lamps and their fittings” are acceptable according to the ID Manual.

### **Class 17**

The Examining Attorney objected to the wording in this class, which, in its entirety, is “building and framing accessory and installation components, namely, rubber washers and plastic conduits.” Applicant respectfully submits that its rubber washers and plastic conduits, which are stated to be for building purposes, are acceptable. Below are the relevant screenshots from the ID Manual:

**Refine Search:** (RUBBER\$ WASH\$)

**Return results with status:** ☒ A - Added ☒ M - Modified ☒ X - Examples ☐ D

[Click here](#) for more information about Manual entry status

*Documents: 1 - 2 of 2*

<i>Hit No.</i>	<i>Class</i>	<i>Description</i>	<i>Status</i>	<i>Effective Date</i>	<i>Type</i>	<i>Note</i>	<i>TM5</i>
1	017	Washers of rubber for {indicate use}	A	02 Apr 91	G	N	
2	017	Washers of rubber or vulcanized fiber	A	20 Jul 04	G	N	T



017 **Plastic** tubes for {indicate use, e.g. protecting electrical wires, milking machines, etc.} [**conduits**; not packaging]

03-06-2014: Entry clarified by inclusion of examples within curly brackets and informational matter within square brackets. Tubes and pipes are generally classified by material composition when used as building materials or when their function is not otherwise mentioned in a Class Heading. Other tubes with more specific purposes are classified based on such purpose, such as glass tubes for scientific purposes in Class 9 and endotracheal tubes in Class 10, regardless of their material composition.

## **Class 19**

The first clause in this class to which the Examining Attorney objected is “non-metal structural building and framing products, and accessory components therefor, namely, trolley and conveyor assemblies and parts, end caps and closure strips for channel and tubing members, shelf brackets, beam clamps, concrete inserts, partition and display fittings and moldings, ducts, and door jambs.” The Examining Attorney stated that this wording could include goods in other classes, and gives “non-metal shelf brackets” and “beam clamps” as examples of goods in Class 20, “electrical ducts” in Class 9, “ducts for heating and ventilation” in Class 19 and “cable organization ducts” in Class 20. Applicant respectfully disagrees because Applicant’s goods are explicitly stated to be “non-metal ***structural building and framing products***, and accessory components therefor, namely,...” Thus, for example, Applicant’s shelf brackets are *building* products and not, say, shelf brackets one might use in a home office. This is why Applicant’s goods are in Class 19, for which the short title is “non-metallic building materials.” In an effort to perhaps clear up the general nature of Applicant’s goods, below is a screenshot from Applicant’s catalog:



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Applicant also notes that “non-metal ducts” are in Class 19 according to the ID Manual.

Lastly, the Examining Attorney objected to the second clause in Class 19, which is “non-metal building and framing accessory and installation components, namely, nuts, bolts, screws, studs, hinges, springs for use as hardware, spring clips for use as hardware, pipe couplings, pipe clamps, pipe rollers for use as hardware, pipe hangers, fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers.” Applicant respectfully submits that these goods are also properly classified in Class 19, for the same reason the first clause is.



**IV. Conclusion**

For the foregoing reasons, Applicant respectfully requests that the Board reverse the requirement for an amendment to the identification of goods.

Respectfully submitted,

Date: October 6, 2015

/Michael E. Hall/

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